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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/390,026	09/03/1999	CHARLES A. PEYSER	07710.0001-0	6211

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EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/390,026	Applicant(s) PEYSER ET AL.	
	Examiner Yogesh C Garg	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 December 0200.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37-CFR-1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Response to Office Action, paper number 7 received on 12/16/2002, is acknowledged and entered. No amendments, cancellations and additions have been made to the originally filed claims. Currently claims 1-38 are pending for examination.

### ***Response to Arguments***

2. Applicant's arguments with respect to 35 U.S.C. 112, second paragraph rejection of claims 4 and 17 have been considered but are not persuasive. While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "demographics" in claims 4 and 17 is used by the claim to mean "characteristics to identify the business of the buyer for which he needs telecommunications service," while the accepted meanings are "a) statistical characteristics of human population --as age or income ", see Webster's Collegiate Dictionary. It is suggested to replace the term "demographics" by --characteristics--

Rest of the applicant's arguments with respect to claims 1-38 have been considered but are moot in view of the new ground(s) of rejection.

This is a non-final rejection.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947).

The term “demographics” in claims 4 and 17 is used by the claim to mean “characteristics to identify the business of the buyer for which he needs telecommunications service,” while the accepted meanings are “a) statistical characteristics of human population –as age or income “, see Webster’s Collegiate Dictionary. It is suggested to replace the term “demographics” by –characteristics--.

Note: for future prior art search and rejection examiner has considered the term “characteristics” instead of demographics.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giovannoli (US Patent 5,758,328).

With regards to claims 1-6, 8-19, and 21-38, Giovannoli discloses a computerized method and system comprising (see at least col.2, line 35-col.8, line 20, FIGS1, 2A, 2B, 3, 4,5,6,7,8.):

- Receiving a request for purchasing at least one service from a buyer;
- Providing the request to a plurality of seller terminals, each of the seller terminals being associated with a different provider of services and receiving a reply from at least one of the seller terminal;
- Providing a reply to the buyer;
- Receiving a selection from the buyer in response;
- Notifying the provider of the selection and identity of the buyer;
- Registering the buyer prior to receiving the request;
- Obtaining contact information from the buyer;
- Obtaining the buyer name;
- Assigning a password to the buyer;
- Obtaining business characteristics of the buyer;
- Identifying billing preferences for the service;
- Receiving information as to the location, the needed goods/services, and the features of the goods/services;

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- Compiling a list of providers to receive the request;
- Sending information to those providers;
- Verifying an identity of the buyer and presenting the request to the seller terminals only when the identity of the buyer is verified;
- Presenting contractual terms for the desired services;
- Receiving acceptance of the terms from the buyer;
- Receiving from seller terminals, filtering criteria that specifies types of requests the providers want to receive and distributing the request to seller terminals based on the filtering criteria.
- A memory that stores data;
- A processor that can automatically prepare a bid from the sellers;
- Transfer the automatically prepared bid to the user and allow the user to

respond; and

- Provides the sellers with the identification of the buyer.

Note: vendors, Buyer's data packet as demonstrated in FIG.7, in Giovannoli correspond to providers and obtaining business characteristics in the application.

Further, vendor terminals as indicated in FIG.1, correspond to seller terminals.

Giovannoli does not disclose that the products/services being purchased and sold include telecommunication services. However, Giovannoli's process and system are pertinent to the particular problem of the claimed invention of purchasing telecommunication services as analyzed above. Giovannoli's disclosure constitutes an "Analogous Prior Art" for selling telecommunication services. Therefore it would be

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obvious to a person of an ordinary skill in the art at the time of the invention that method steps, system/article of manufacture disclosed in Giovannoli would also be capable for purchasing and selling telecommunication services within the mete and bounds of the claims specified in the application and to use it for purchasing telecommunication services. See MPEP 2141.01(a) Analogous and Nonanalogous Art :TO RELY ON A REFERENCE UNDER 35 U.S.C. 103, IT MUST BE ANALOGOUS PRIOR ART. The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); and Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

With regards to claims 7, and 20, Giovannoli teaches a method and system purchasing telecommunication services, as disclosed and analyzed above. Giovannoli does not disclose obtaining information regarding prior use of telecommunication

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services of the buyer. However, as per knowledge generally available it is very well known that salesmen do enquire from buyers information regarding prior use of services or products they purchase. For example, when buying a car at a dealer, the car salesmen always want to know which car you want to trade, or telemarketers for loans enquire the buyers their existing rate of interest, or telemarketers for long distance telephone services enquire about the present service. Knowing information about the prior use helps the salesmen to compare their products with the products used earlier by the buyers and tell the salient facts about their products. In view of this knowledge generally available it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Giovannoli to include the step of obtaining information about prior use of the service from the buyer because this information will help the salesmen to better convince the buyers to buy their products, as explained above in the examples.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US patents 5,815,665 to Teper et al., 5,881,131 to Farris et al., 6,104,798 to Lickiss et al., 6,269,157 to Coyle and PUB.NO. 2002/0001372 A1 disclose purchasing of online and telecommunication services on line.



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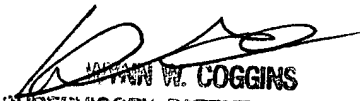
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg  
Examiner  
Art Unit 3625

YCG  
February 4, 2003

  
WYNN W. COGGINS  
SUPERVISORY PATENT EXAMINER  
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